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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,321

03/24/2006

Takahisa Hikita

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EXAMINER

HUG, ERIC J

ART UNIT

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1791

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,321	Applicant(s) HIKITA, TAKAHISA	
	Examiner Eric Hug	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-16 is/are allowed.
- 6) ☒ Claim(s) 6 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is in response to the amendment filed September 3, 2008.

Claim Rejections - 35 USC § 102 and 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 6 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Romanski (US 7,374,640).

Romanski discloses a grooved elastic belt for a shoe press (column 1, lines 65-66). The belt is formed by depositing ribbons of an elastic material onto a chemically reactive substrate. The ribbons are placed so as to form raised lands with grooves therebetween extending along a belt travel direction. See column 5, lines 3-29; col. 6, lines 2-3. Figures 2 and 3B show grooves 22 and lands 20, wherein the surface of the lands are entirely curved upwardly as seen as a transverse cross-sectional configuration in the belt width direction. The configuration shown appears to be a semi-circle, equivalently the claimed upward parabolic configuration. A semi-circle is a parabola wherein the vertical component rises as fast as the horizontal component extends. These features read on the press belt of claim 6 and the shoe press roll comprising the belt of claim 10.

Even if one argues that the semi-circular shape of the lands disclosed by Romanski is not an upward parabola as claimed, the claims are unpatentable because an upward parabola is easily obtainable based on the teachings of Romanski. Column 5, lines 30-43 and 53-60 teach that its possible to vary the shape of the deposited material by control of the deposition process, most

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notable the speed by which the ribbons are deposited and the rate of amount of material deposited. One can obtain a parabola which is not a semi-circle by minor variations in the deposition process. Also, a mere change in shape is not patentable. See *In re Dailey*, 149 USPQ 47 (CCPA 1976) (change in form or shape of the prior art without departing from its function or intended purpose is an obvious engineering design).

Response to Arguments

Applicant's arguments filed September 3, 2008 have been considered.

In view of the arguments and amendment to the claims, Applicant has overcome the prior art references Jermo (US 5,543,015), Ishii (US 6,296,738), and Matuschczyk (US 6,416,630), applied previously. Also, the rejection of claim 9 under 35 U.S.C. 112, second paragraph, has been rendered moot by cancellation of claim 9.

Applicant's arguments regarding Romanski are not persuasive for claims 6 and 10.

Applicant argues that Romanski does not disclose a press belt wherein the lands are spaced apart from each other by the groove therebetween, and wherein the transverse sectional configuration of the land is an upward parabolic configuration, as recited in claim 6. However, these features are clearly pointed out in Romanski as described above. Applicant makes no distinction (including drawings) between the claimed upward parabolic configuration and the shape of the lands presented by Romanski.

Applicants arguments regarding Romanski are persuasive for new claims 11-16. It is recognized the Romanski does not teach upwardly parabolic lands having a linear part, and because no such linear part exists, Romanski does not meet the claims for a width "s" = zero.

Allowable Subject Matter

Claims 11-16 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The claims are allowed for providing lands and grooves arranged as claimed, wherein the lands have an upper surface which is curved upwardly and comprises a linear part on its top as a transverse sectional configuration along a belt width direction, and wherein the relation of the defined widths $s/W < 0.5$.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Hug whose telephone number is (571) 272-1192.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric Hug/
Primary Examiner, Art Unit 1791